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10/021,787	12/17/2001	Eiichiroh Hosoi	JP920000428US1	1983

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EXAMINER	
JEAN GILLES, JUDE	
ART UNIT	**PAPER NUMBER**
2143	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/021,787	HOSOI, EIICHIROH	
	Examiner	Art Unit	
	Jude J. Jean-Gilles	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 November 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 December 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This Action is in regards to the Reply filed on 06/15/2006.

Response to Amendment

1. This action is responsive to the application filed on 11/09/2006. No claims were amended. There are no newly added claims. Claims 1-16 are pending. Claims 1-16 represent a method and apparatus for "ELECTRONIC MAIL COMMUNICATING METHOD, APPARATUS AND SYSTEM USING FACSIMILE COMMUNICATION PROCEDURE."

Response to Arguments

2. Applicant's arguments with respect to claims 1, 4, 6, 9, 12, 13, 15, and 16 have been carefully considered, and are not deemed persuasive. Applicant's arguments are deemed moot in view of the following new ground of rejection as explained here below, necessitated by applicants' remarks made in the amendment dated 11/09/2006. The new reference of Umansky discloses applicants' main point of contention, namely " the cited references fail to teach or suggest converting said electronic mail data converted into said image form back into electronic mail data in the electronic mail format" [see Umansky, column 11, lines 7-19, and lines 40-48].

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 1-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over The combination Yoshida-Thompson et al (hereinafter Yoshida), Patent No. 6,801,546 B1 in view of Umansky, U.S. Patent No. 7,142,550 B1.

Regarding **claim 1**, Yoshida discloses the invention substantially as claimed. Yoshida discloses a method for communicating electronic mail data from a sender to a receiver via a network (fig. 1), comprising the steps of:

(a) recognizing a dial number of said receiver corresponding to destination address information attached to said electronic mail data (column 14, lines 37-65; column 18, lines 1-39);

(b) converting said electronic mail data into an image form permitting facsimile communication, wherein said electronic mail data originates in and electronic mail format (column 12, lines 61-67; column 13, lines 1-31); and

(c) initiating a call to said receiver using said recognized dial number and transmitting said electronic mail data converted into said image form to the receiver by facsimile communication procedures, wherein said image form is adapted to be restored into electronic mail data in the electronic mail format (column 23, lines 34-67).

However, Yoshida appears not to disclose the details a method of communicating electronic email wherein "said electronic email data originates in an electronic mail format, and converting said electronic mail data converted into said image back into electronic mail data in the electronic mail format".

In the same field of endeavor, Thompson discloses "...*converting the first email message packets into first fax pages of a fax document; transmitting the first fax pages to a recipient fax machine; upon failure to successfully transmit at least one of the first fax pages of the fax document to the recipient fax machine, converting the failed fax pages into secondary email packets for re-transmission thereof to the recipient fax machine; and transmitting one or more of the first email message packets to a destination other than the recipient fax machine...wherein the first portion of the first email message included within the second email message corresponds to the facsimile information that was unsuccessfully transmitted as a result of the failure; wherein the network processing device reconverts the unsuccessfully transmitted facsimile information into an email message format for inclusion within the second email message* ..." [see Umansky, column 11, lines 7-19, and lines 40-48].

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Umansky's teachings of originating email data in an electronic mail format, and converting said electronic mail data converted into said image back into electronic mail data in the electronic mail format with the teachings of Yoshida, for the purpose of improving the ability of a network "...*to provide a* method and a system whereby the fax document having been

created by conversion of an email message to the fax document, the apparatus and method causing a limited number of transmissions thereby resulting in lower costs and less waste to the user of the fax recipient..." as stated by Umansky in lines 62-67 of column 2. By this rationale, **claim 1** is rejected.

Regarding **claim 2**, the combination Yoshida-Umansky discloses the method as set forth in claim 1, wherein the step of converting comprises the step of determining a horizontal number of pixels and generating data by linking the data with the horizontal number in a vertical direction according to a specification based on ITU-T Recommendation T-30 (see Yoshida; column 14, lines 28-65).

Regarding **claim 3**, The combination Yoshida-Umansky discloses the method as set forth in claim 2, wherein the step of converting further comprises the step of generating data to be transmitted by using a mail body in which said electronic mail data are recognized to be a series of binary values, a header representing said image form, and a padding for linking the mail body and the header by adjusting line width of the horizontal numbers of pixels (see Umansky; column 4, lines 6-26).

Regarding **claim 4**, The combination Yoshida-Umansky discloses an electronic mail communicating method, comprising the steps of:

(a) retrieving mail information stored in a server (fig. 1, item 1-3) to be transmitted over a switched line (fig. 1, item 1-6) from the server wherein said electronic mail data originates in and electronic mail format (see Yoshida; column 8, lines 36-67);

(b) selecting a specification of communication needed for communication over the switched line from a network address contained in said mail information (see Yoshida; column 17, lines 8-64); and

(c) initiating a call to said switched line using the selected specification of communication, and transmitting said mail information according to facsimile communication procedures to a receiving apparatus connected via the switched line (see Yoshida; column 23, lines 34-67).

(d) forwarding said mail information from the receiving apparatus to the network address according to the electronic mail format [see Umansky, column 11, lines 7-19, and lines 40-48].

Regarding **claim 5**, The combination Yoshida-Umansky discloses the electronic mail communicating method as set forth in claim 4, wherein the step of retrieving comprises the step of retrieving said mail information with recognition that the mail information is to be transmitted from said network address via said switched line (see Yoshida; column 23, lines 34-67; column 17, lines 8-64).

Regarding **claim 6**, The combination Yoshida-Umansky discloses an electronic mail communicating method, comprising the steps of:

(a) receiving data containing electronic mail information converted into an image form permitting facsimile communication from a sender wherein said electronic mail data originates in and electronic mail format [see Umansky, column 11, lines 7-19, and lines 40-48].

(b) converting said received data into electronic mail information (see Yoshida; column 23, lines 5-65);

(c) analyzing a destination contained in the converted electronic mail information; (d) generating reply information to converted electronic mail information (see Yoshida; column 23, lines 5-65); and

(e) converting said reply information into said image form and sending the converted reply information to the sender (see Yoshida; column 24, lines 8-67).

Regarding **claim 7**, The combination Yoshida-Umansky discloses the electronic mail communicating method as set forth in claim 6, wherein, if a terminal with a destination corresponding to said analyzed destination is not connected to an internal network, reply information representing absence of any relevant destination is generated (see Yoshida; column 34, lines 39-65).

Regarding **claim 8**, The combination Yoshida-Umansky discloses the electronic mail communicating method as set forth in claim 6, wherein, if received data do not contain electronic mail information, conventional facsimile reception operation takes place (see Yoshida; column 34, lines 3-38).

Regarding **claim 9**, The combination Yoshida-Umansky discloses an electronic mail transmitting apparatus for transmitting electronic mail data to a receiver using a switched line not through the Internet (fig. 1, item 1-6), comprising:

a communication specification determination unit for determining a specification of communication with said receiver for communication over said switched line based

on destination address information for an external network assigned to the electronic mail data (see Yoshida; column 23, lines 34-67);

a conversion unit for converting electronic mail data to be transmitted into a data form for communication over said switched line wherein said electronic mail data originates in and electronic mail format (fig. 3, item 3-10, column 17, 32-51; column 12, lines 61-67; column 13, lines 1-31); and

a transmission unit for transmitting said electronic mail data converted into said data form by said converting unit, to said receiver in accordance with said specification of communication determined by said communication specification determination unit, using said switched line(see Yoshida; column 17, lines 8-64; column 18, lines 10-64) and

a reconversion unit for converting said electronic mail data converted into said data form that has been received over said switched line into electronic mail data in the electronic mail format [see Umansky, column 11, lines 7-19, and lines 40-48].

Regarding **claim 10**, The combination Yoshida-Umansky discloses the electronic mail transmitting apparatus as set forth in claim 9, wherein said communication specification determination unit stores in advance correspondence information among destination address information for a network assigned to electronic mail data, a dial number of said receiver and a communication procedure based on ITU-T Recommendation T-30, and determines the specification of communication based on the stored correspondence information (see Yoshida; column 14, lines 28-65).

Regarding **claim 11**, The combination Yoshida-Umansky discloses the electronic mail transmitting apparatus as set forth in claim 9, wherein said conversion unit recognizes data contained in said electronic mail data as a series of binary values, and converts the data form by adjusting line widths. Note that a conversion unit that recognizes mail data as binary values is well known in the art.

Regarding **claim 12**, The combination Yoshida-Umansky discloses an electronic mail transmitting apparatus, comprising:

a mail retrieving unit for retrieving from a server mail information to be transmitted over a switched line wherein said electronic mail data originates in and electronic mail format (see Yoshida; column 8, lines 36-67);

a communication specification determination unit for determining a specification of communication for communication over the switched line based on a network address contained in said mail information retrieved by said mail retrieving unit (see Yoshida; column 17, lines 8-64); and

a transmission unit for initiating a call on said switched line using said specification of communication determined by said communication specification determination unit and transmitting said mail information to a receiving apparatus connected via the switched line by facsimile communication (see Yoshida; column 23, lines 34-67) wherein the receiving apparatus converts the mail information back into the electronic mail format [see Umansky, column 11, lines 7-19, and lines 40-48].

Regarding **claim 13**, The combination Yoshida-Umansky discloses a mail receiving apparatus for receiving electronic mail data originating in an electronic mail

format that has been converted into a form permitting facsimile communication from a sender via a switched line [see Umansky, column 11, lines 7-19, and lines 40-48]., comprising:

a receiving unit for receiving data from said sender via said switched line by facsimile communication (see Yoshida; column 29, lines 20-62);

a restoring unit for restoring said data received by said receiving unit into electronic mail data (see Yoshida; column 23, lines 5-65); and

a transferring unit for transferring said electronic mail data restored by said restoring unit to a server connected to an internal network(see Yoshida; column 17, lines 8-64; column 18, lines 10-64; see Umansky, column 11, lines 7-19, and lines 40-48).

Regarding **claim 14**, The combination Yoshida-Umansky discloses the electronic mail receiving apparatus, as set forth in claim 13, further comprising:

a destination recognition unit for recognizing a destination of the electronic mail data based on said electronic mail data restored by said restoring unit (see Yoshida; column 14, lines 37-65; column 18, lines 1-39; column 23, lines 5-65); and

a notification unit for notifying the sender if the destination recognized by said destination recognition unit is not in said internal network (see Yoshida; column 34, lines 39-65).

Regarding **claim 15**, The combination Yoshida-Umansky discloses an electronic mail communication system, comprising:

an Internet-connected transmission mail server; a transmission client connected to the transmission mail server to instruct transmission of electronic mail, and a transmission agent connected to a switched line to function as a client to the transmission mail server (see Yoshida; fig. 1, items 1-3, 1-5; column 8, lines 36-67),

wherein said transmission client outputs, to said transmission mail server, electronic mail data in an electronic mail format that includes a description of a destination of said transmission agent and a description of a final mail destination (see Yoshida; column 14, lines 37-65; column 18, lines 1-39); and

wherein said transmission agent retrieves electronic mail data in which the destination of the transmission agent is described by said transmission client from said transmission mail server and transmits the electronic mail data using facsimile communication procedures using the switched line to the receiving apparatus that reconverts the electronic mail data into an electronic mail format (see Yoshida; column 23, lines 34-67; column 17, lines 8-64; see Umansky, column 11, lines 7-19, and lines 40-48).

Regarding **claim 16**, The combination Yoshida-Umansky discloses an electronic mail communication system for transmitting and receiving electronic mail information between an internal network on a sender side and an internal network on a receiver side (see Yoshida; column 14, lines 37-65; column 18, lines 1-39), wherein

the internal network on the sender side comprises a transmission mail server, a transmission client for generating electronic mail information, and a transmission agent which is a client having a function for transmitting the electronic mail information in a

facsimile format via a switched line (see Yoshida; column 23, lines 34-67; column 17, lines 8-64; fig. 1, items 1-3, 1-5, 1-6; see Umansky, column 11, lines 7-19, and lines 40-48);

the internal network on the receiver side comprises a reception mail server, a reception client which is a final destination of the electronic mail information, and a reception agent which is a client having a function for receiving the electronic mail information via a switched line (fig. 1, items 1-9, 1-10, 1-6);

said transmission agent transmits an electronic mail message whose final destination is said reception client designated by said transmission client to said reception agent via said switched line (see Yoshida; column 23, lines 34-67; column 17, lines 8-64);

said reception agent transfers said electronic mail received via said switched line to said reception mail server in an electronic format (see Yoshida; column 14, lines 37-65; column 18, lines 1-39; see Umansky, column 11, lines 7-19, and lines 40-48).

Conclusion

5. Applicant's remarks necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE NON-FINAL**. The Examiner strongly anticipates a Final Rejection Office Action on the next response if amendments are not properly made to the claims to perhaps place them in condition for allowance.

Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-9000.

Jude Jean-Gilles

Patent Examiner

Art Unit 2143

JJG

January 18, 2007

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